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**C. REMARKS****1. Status of the Claims**

Claims 1-6, 9-12, and 15-18 are currently pending in the Application and stand rejected. Claims 1, 9, and 15 are independent claims and have been amended to include the limitations originally found in claims 7, 13, and 19, respectively, and claims 7, 13, and 19 have been cancelled. No claims have been added in this Response.

**2. Examiner Discussion**

Applicants' undersigned attorney telephoned the current Examiner, Boris M. Pesin, shortly after receipt of the present Office Action. Applicants' attorney was concerned regarding the alleged prior art reference termed "Microsoft Word 2000 (Screen Shots)." Figure 4 of the reference is simply a screen shot of a document being edited using the Microsoft Word word processor with heading language remarkably similar to Applicants' node identifiers. Applicants' attorney inquired as to where the Examiner had found the Figure 4 screen shot. The Examiner responded that the Examiner had typed the text into a Microsoft Word document and printed the screen shot from the document. Applicants' attorney informed the Examiner that, because the document was created by the Examiner, it did not constitute prior art. Furthermore, Applicants' attorney informed the Examiner that the Examiner's attempt to pass the screen-shot off as a prior art reference was highly troubling and not allowed under procedures promulgated by the MPEP.

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**3. Previous Examiner Interview**

Applicants note that the Examiner of the application has changed. Applicants respectfully remind the current Examiner that a previous interview was conducted between Applicants' attorney, Examiner Golinkoff, and Supervisory Examiner Kincaid on Tuesday February 17, 2004 at 1:00PM E.T. concerning related application (Serial No. 09/838,602). During the interview, the participants discussed the reference of Lokuge (U.S. Pat. No. 6,252,597) and agreed that an amendment to the independent claims pointing out that the visual markers claimed by Applicants are "overlaid" would overcome the rejection.

**4. Allowable Subject Matter**

Applicants note with appreciation the allowability of claims 8, 14, and 20. These claims were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of Applicants' arguments pertaining to the independent claims, however, Applicants are firmly convinced that all of Applicants' remaining claims are allowable over the art cited by the Examiner.

**5. Claim Rejections - 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1, 9, and 15 for including a relative term. Applicants' respectfully traverse the rejection.

The term in question, "substantially similar," is used to position the left margin of a formatted data item and an alphanumeric level identifier in a position "substantially similar" to a left margin of the other data items. Applicants submit that the use of the term "substantially similar" does not

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render the claim indefinite because it can readily be understood by those of skill in the art that Applicants are claiming that the left margins of the two items are roughly equal to each other. The use of a term, such as "substantially similar," is allowed under MPEP § 2173.05(b) in a case, such as this, where the term is readily understood by one of skill in the art. MPEP 2173.05(b) states as follows:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

Applicants submit that an example provided under 2173.05(b) is similar to Applicants' claim language and was held as being definite under 35 U.S.C. § 112 (see 2173.05(b)(D) where the court held that the limitation "which produces substantially equal E and H plane illumination patterns" was held as being definite because one of ordinary skill in the art would know what was meant by "substantially equal." Finally, Applicants further note that this claim language was discussed with Examiners Golinkoff and Kincaid during the interview conducted on February 17, 2004 and did not raise an issue at that time, nor did the limitation raise a rejection in the First Office Action.

**6. Rejections 35 U.S.C. § 103, Alleged Obviousness**

Claims 1-6, 9-12, and 15-18 stand rejected under 35 U.S.C. § 103 as being obvious, and therefore unpatentable, over U.S. Patent No. 6,252,597 to Lokuge (hereinafter "Lokuge") in view of

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non-prior art reference "Microsoft Word 2000 (Screen Shots)" (hereinafter "Examiner-Created Art").

The Office Action asserts that Lokuge teaches Applicants' invention as claimed in original claim 1 and cites various sections of Lokuge in support of this assertion. While both Lokuge and Applicants' invention address a common, general, shortcoming in the art (namely displaying hierarchical data), they address the shortcomings in different and distinct ways. Lokuge teaches using a smaller font size for subcategory information in a hierarchical list (see Figure 7). In Figure 7, Lokuge shows the word "companies" in a larger font with examples of specific companies listed in a smaller font type underneath the "companies" category. Lokuge also teaches differentiating between items in other ways, as set forth in col. 7, lines 35-45:

In the example shown on the figures, the expansive locations are differentiated by color and by text descriptor ("news", "files"). In the example, the lower-tier contents of a particular category are displayed having the same color as the expansive location of the related upper-tier category. However, differentiation may be accomplished, for example by shading, highlighting, font size or shape, and category shape. For example, different expansive locations and tiers may be distinguished by use of different fonts, font size, scale, texture, color, sound, or by indentation, as well as by the inclusion of animation or video information. Furthermore, different tiers may have different configurations, such as the cluster arrangement, described in detail below.

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In the preceding text, Lokuge describes using a laundry list of methods, while only teaching aspects regarding font sizes, indentation, and color. Importantly, however, and as discussed during the Examiner Interview, nowhere does Lokuge teach or suggest using alphanumeric level indicators as claimed by Applicants in amended claim 1. Instead, as illustrated by the preceding section, Lokuge teaches differentiating between hierarchical items using color and / or font size attributes on the displayed items themselves, and does not teach or suggest using an overlaid visual marker, as taught and claimed by Applicants in amended claims 1, 9, and 16. Furthermore, the Office Action admits that Lokuge does not teach or suggest using alphanumeric level indicators in the rejection of original claims 7, 13, and 19, the limitations of which having been incorporated into independent claims 1, 9, and 14, respectively. However, the Office Action contends that Examiner-Created Art teaches displaying an alphanumeric level identifier with each formatted data item that identifies the level corresponding to the formatted data item, citing Figures 1-5 of the Examiner-Created Art in support of this contention.

Applicants assert that the reliance on the Examiner-Created Art is wholly improper and simply not allowed under procedures promulgated in the Manual of Patent Examining Procedures. The Office Action describes the Examiner-Created Art as "displaying the formatted data item and an alphanumeric level identifier in the display window, wherein the alphanumeric level identifier identifies the data layer corresponding to the formatted data item." Figure 4 from the Examiner-Created Art includes alphanumeric level identifiers that identify data layers. However, as described in Section 2 above, Figure 4 was created

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by the Examiner in order to look like Applicants' claimed invention.

The Examiner states that "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lokuge with the teachings of [the Examiner-Created Art] and include a method to display alphanumeric level identifiers corresponding to the formatted data item with the motivation to provide the user a convenient method of organizing the data wherein the data is quickly discernable by the end user." Applicants submit that the Examiner's statement is simply not true. This is because the Examiner-Created Art did not exist at the time of Applicants' invention. Section 900 of the MPEP covers "Prior Art, Classification, Search." Nowhere in the MPEP, in particular MPEP § 900, is the Examiner allowed to create prior art and use the art as a basis for rejecting Applicants' claims.

Applicants respectfully submit that, without the use of the Examiner-Created Art, there is no plausible basis for the Examiner's rejection of Applicants' claims. As described above, the Examiner-Created Art is not prior art as at least one key Figure in the Examiner-Created Art was created long after Applicants' filed their patent application. MPEP § 2128 discusses "printed publications" as prior art. The Examiner-Created Art clearly falls outside of allowable prior art, as well as outside the use of allowable "electronic documents" found online or on the Internet:

**2128 "Printed Publications" as Prior Art**

A REFERENCE IS A "PRINTED PUBLICATION" IF IT IS  
ACCESSIBLE TO THE PUBLIC

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A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." In re Wyer, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting I.C.E. Corp. v. Armco Steel Corp., 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) ("We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the 'probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively, now seems to render their use in the phrase 'printed publication' somewhat redundant.") In re Wyer, 655 F.2d at 226, 210 USPQ at 794.

See also Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (Starlight Archery argued that Carella's patent claims to an archery sight were anticipated under 35 U.S.C. 102(a) by an advertisement in a Wisconsin Bow Hunter Association (WBHA) magazine and a WBHA mailer prepared prior to Carella's filing date. However, there was no evidence as to when the mailer was received by any of the addressees. Plus, the magazine had not been mailed until 10 days after Carella's filing date. The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before the filing date there could be no rejection under 35 U.S.C. 102(a).).

...

MPEP § 2128 also provides rules for ascertaining the date an electronic document is considered "publicly available." Because the Examiner-Created Art was created by the Examiner

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after viewing Applicants' invention and never stored on a publicly available site, the Examiner-Created Art is neither "prior art," nor a "publication" under the MPEP rules. This section of MPEP § 2128 states as follows (emphasis added):

## Date of Availability

Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

In addition, the Examiner has admittedly used impermissible hindsight in rejecting Applicants' claims. The Examiner admitted creating the Examiner-Created Art, especially Figure 4. MPEP § 706 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the



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teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid ( 35 U.S.C. 282) and constitute a property right ( 35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

Applicants assert that the Office Action fails to satisfy the burden set forth in § 706.02(j) in support of an obviousness objection, particularly because the Examiner would not have created the Examiner-Created Art without relying on Applicants' disclosure. Thus, it is painfully clear that the Examiner used impermissible hindsight in rejecting Applicants' claims.

Each of the remaining claims setting forth the limitations of Applicants' invention were rejected using an impermissible reference, namely the "Microsoft Word 2000 (Screen Shots)" which were impermissibly created by the Examiner solely for use in rejecting Applicants' claims. The "Microsoft Word 2000 (Screen Shots)" does not qualify as a "prior art reference" because (1) it did not exist prior to Applicants' invention, and (2) it has never been made "publicly available." Applicants' claimed invention is allowable over Lokege. Applicants' established

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this fact when successfully traversing the Lokuge reference cited as a 102 reference in the First Office Action. The Examiner admits that Lokuge does not teach or suggest each of Applicants' claimed limitations. To overcome this shortcoming, the Examiner improperly created "Microsoft Word 2000 (Screen Shots)." Therefore, this reference cannot be used to reject Applicants' claimed invention. As a result, Applicants' respectfully submit that claims 1-6, 9-12, and 15-18 are allowable over the prior art of record.


Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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